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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,827	10/11/2001	Mitsuyuki Hatanaka	450100-03538	2274

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FROMMER LAWRENCE & HAUG
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NEW YORK, NY 10151

EXAMINER

HAMILTON, MONPLAISIR G

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 03/25/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,827

Applicant(s)

HATANAKA ET AL.

Examiner

Monplaisir G Hamilton

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 1-4 are pending.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d).

Specification

3. The disclosure is objected to because of the following informalities: applicant has used inconsistent terminology while referencing unit 104 (Drawings: Fig. 3). Applicant has referred to this unit as a piece managing unit and a price managing unit (e.g. specification: page 21, lines 1-5). Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6687802 issued to Kori et al, herein referred to as Kori.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Referring to Claims 1, 3 and 4:

Kori discloses an information processing apparatus having functions for recording contents recorded on a first recording medium onto a second recording medium, said apparatus comprising: recording means for recording said contents recorded on said first recording medium onto said second recording medium (col 4, lines 40-50);

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recording history information storing means for storing information regarding said contents as recording history information at the time of said contents recorded on said first recording medium being recorded onto said second recording medium by said recording means (col 6, lines 40-45; col 8, lines 1-5; col 9, lines 5-20; col 10, lines 30-40); and

display means for searching for information regarding said contents stored as recording history information by said recording history information storing means at the time of said contents recorded on said first recording medium being recorded onto said second recording medium again by said recording means, and displaying said information (col 13, lines 40-45; col 15, lines 35-45;).

Referring to Claim 2.

Kori discloses the limitations of Claim 1 above. Kori further discloses said recording history information contains audio recording history information which records the number of times that audio recording has been made for each track of said first recording medium, title saving information of said contents, and play list information (col 13, lines 5-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 rejected under 35 U.S.C. 103(a) as being unpatentable over US 6034832 issued to Ichimura, herein referred to as Ichimura further in view of US 6615192 issued to Tagawa, herein referred to as Tagawa.

Referring to Claims 1, 3 and 4:

Ichimura discloses an information processing apparatus having functions for recording contents recorded on a first recording medium onto a second recording medium, said apparatus comprising: recording means for recording said contents recorded on said first recording medium onto said second recording medium (col 2, lines 5-20);

recording history information storing means for storing information regarding said contents as recording history information at the time of said contents recorded on said first recording medium being recorded onto said second recording medium by said recording means (col 2, lines 15-30; col 11, lines 5-10; col 13, lines 20-35); and

display means for searching for information regarding said contents stored as recording history information by said recording history information storing means at the time of said contents recorded on said first recording medium being recorded onto said second recording medium again by said recording means (col 22, lines 45-60).

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Ichimura does not explicitly "disclose displaying said information".

Tagawa discloses displaying said information (Fig 9; col 10, lines 50-65; col 13, lines 10-25;).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Ichimura such that the searched history information corresponding to a file being recorded again is displayed. One of ordinary skill in the art would have been motivated to do this because it would allow the user to easily determine how many authorized copies were made (Fig 9).

Referring to Claim 2.

Ichimura discloses the limitations of Claim 1 above. Ichimura further discloses said recording history information contains audio recording history information which records the number of times that audio recording has been made for each track of said first recording medium, title saving information of said contents, and play list information (col 5, line 60-col 6, line 15; col 8, lines 25-50).

Prior Art

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5956716 issued to Kenner, Brian et al. Kenner discloses a video clip storage and retrieval system whereby video clips, stored locally and/or at a more remote location, can be requested and retrieved by a user at the user's multimedia terminal. When the user requests a

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desired video clip, the request is processed by a primary index manager ("PIM") via a Local Search and Retrieval Unit ("SRU"). Before the message is communicated to the PIM, the local SRU checks its own storage to see whether the requested video clips are available locally. If some of the video clips are local, the local SRU still forwards the request to the PIM so that the PIM may determine specific video clip usage. The PIM determines the extended SRU where the audio-visual data is stored and passes this information to a Data Sequencing Interface ("DSI"). The DSI collects the video clips and downloads the clips to the user's terminal. The user may then view, copy, or print the video clip as desired. In a preferred embodiment, a distributed digital video clip delivery system, according to the invention, provides video clips stored at local and/or remote locations, which can be requested from the Internet and retrieved at the user's multimedia terminal. When the user requests a desired video clip shown on a Web page, the request is diverted to a primary index manager ("PIM"). The PIM attempts to locate the closest server containing the requested clip, from which the download is completed. The system further includes means for uploading and distributing clips to geographically diverse servers, dynamic load balancing, subscription management mechanisms, and protection means to discourage unauthorized duplication of video clips.

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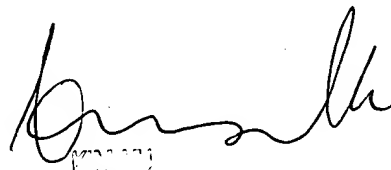
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monplaisir G Hamilton whose telephone number is (703) 305-5116. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703) 305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Monplaisir Hamilton



Monplaisir G. Hamilton
Examiner
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